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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/787,130	02/27/2004	Naoyuki Ezaka	Q80148	4669
65565	7590	08/20/2008		
SUGHRUE-265550				
2100 PENNSYLVANIA AVE. NW				
WASHINGTON, DC 20037-3213				
EXAMINER				
XAVIER, VALENTINA				
ART UNIT		PAPER NUMBER		
3644				
MAIL DATE		DELIVERY MODE		
08/20/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/787,130

Applicant(s)

EZUKA, NAOYUKI

Examiner

VALENTINA XAVIER

Art Unit

3644

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5/2/2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 – 4, 9, 12, 15 and 17 are rejected under 35 U.S.C. 103(a) as being obvious over Yamamoto (US 5,048,223) in view of Wallace (US 3,778,916) and Werner (US 6,620,286).

Yamamoto et al. '223 discloses a fishing rod comprising a rod pipe 11 that is inserted into a reinforced tubular body 12 (**See Fig. at the end of this Office Action**), and a body (material between 12a and 12e – See Fig. at the end of this Office Action) that is integrally molded with an outer side of the tubular body 12, See Fig. 2. Yamamoto et al '233 fails to disclose the body (material between 12a and 12e – See Fig. at the end of this Office Action) being a synthetic resin body, however, Yamamoto et al '223 discloses forming the tubular body 12 out of synthetic resin (col. 4, ll 25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the body taught by

Yamamoto et al '223 using synthetic resin as used to form the tubular body 12 in order to provided additional strength.

An adhesive agent (bonding agent, Yamamoto '223, col.4, ll.30-33) is formed in recess 12c works as an adhesive for fixing the grip (13) – this grip is made of a material softer (cork or foam) than that of the bodies it surrounds.

Regarding claim 4, opening 12a is ready to receive a leg of a reel.

Regarding the transparent characteristic of the synthetic resin body, Yamamoto '223 does not positively disclose whether the construction materials used are colored, opaque, transparent, translucent, etc. Wallace discloses a fishing rod having a handle that he teaches may be made of colored or transparent material for decorative purposes (Wallace, col.1, lns.59-63). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a transparent or translucent material for decorative purposes.

Yamamoto '223 fails to disclose the “concealing film”. However, Werner discloses a double-sided tape having a "concealing film" (28). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the adhesive agent of Yamamoto '223 to include the element 28 as taught by Werner in order to provide a carrier for the adhesive to ensure a stronger bond.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being obvious over Yamamoto (US 5,048,223) in view of Wallace (US 3,778,916) and Yamamoto et al (US 6,105,302).

Regarding claim 2, Yamamoto '223, as modified, discloses the claimed invention except it is not positively disclosed that the tubular body is formed of a fiber reinforce prepreg material. Yamamoto '302 teaches the use of such a material, as it is an extremely strong material and will hold up against the forces encountered while sport fishing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a reinforced prepreg material in order to provide a strong and dependable material, since it has been held that there is no invention in the mere selection of a material that is known in the art for its suitability for the intended purpose. *In re Leshin*, 125 USPQ 416.

Regarding claim 3, portion 12d of synthetic body 12 is considered to be a cover portion.

Claims 7, 8, 10, 11, 13, and 16 rejected under 35 U.S.C. 103(a) as being unpatentable over Yamamoto et al. (US 6,105,302).

Yamamoto et al. '302 (Yamamoto '302) discloses a fishing rod, as best viewed in Figures 1, 2, and 11, comprising a rod pipe 1, a reinforced tubular body 2 made of a reinforced synthetic resin (col.3, lns.45-50), and a synthetic resin body 42, 43 which is bonded to an outside of the tubular member 2. The synthetic resin body is disclosed as optionally being made of a synthetic resin (col.4, ln.37), or a foamed resin material (col.3, lns.63-64), both of which are softer than the reinforced pre-impregnated resin of the tubular member 2.

Regarding claim 8, the tubular body is inside member 42 of the resin body and is projected or extends in an axial direction of the tubular body.

Regarding claim 10, the tubular body 2 is made from a fiber reinforced plastic.

Regarding claim 11, member 41 is optionally made from a foamed material, artificial cork, or natural cork (col.3, lns.63-64).

Regarding claim 13, a reel mount is meant to fit inside portion 43 of the resin body (Figure 6).

Yamamoto et al '302 fails to disclose the tubular body and the synthetic resin body being integrally molded. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to integrally mold the two bodies, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works*, 150 U.S. 164 (1893).

Response to Arguments

Applicant's arguments filed 5/2/2008 have been fully considered but they are not persuasive. In response to Applicant's argument regarding the "body" and whether or not it is the same element as the tubular body, Examiner simply shows a separate section being integrally molded to the whole tubular body. The very meaning of being "integrally molded" is that it is part of the same piece.

Applicant also argues that the carrier 28 of Werner *could* be transparent since Werner does not disclose whether or not the polymeric film is transparent or non transparent. However, as Applicant has noted on page 7 of the remarks, the carrier element can be made of other materials such as paper and tissue. Further, the claims do not require that the film be opaque.

Applicant further states that the carrier having adhesive on opposite sides of the carrier is incapable of concealing adhesive on at least one side. However, Fig. 2 shows the liner 16 only having adhesive on one side.

Applicant also argues that the limitation of claim 9 where it calls for a reinforced tubular body being made of material softer than that of the tubular body - however Yamamoto discloses element 13 as being made of cork or foam which is clearly a material softer than that of the tubular body.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee

pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to VALENTINA XAVIER whose telephone number is (571)272-9853. The examiner can normally be reached on Mon - Fri 8:30 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mansen can be reached on (571)272-6608. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3644

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Valentina Xavier

/Michael R Mansen/
Supervisory Patent Examiner, Art Unit 3644

VX

